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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,457	09/16/2003	Keith M. Lombardi	081427-0303578	2516
909	7590	06/29/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			KENNY, STEPHEN	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			3726	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/662,457	LOMBARDI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen J Kenny	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 43-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-54, 58-69, 72-87 is/are rejected.
- 7) ☒ Claim(s) 55-57, 70 and 71 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/14/05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 3/14/05 has been entered.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 43-46, 51, 54, 80-81 are rejected under 35 U.S.C. 102(b) as being anticipated by Coughtrie et al. (GB 2175835 A).

Regarding claims 43, & 80-81, Coughtrie discloses a method of making a tool comprising a pair of pivoting elongated members (11) and metallic blade members (13) welded to the jaw portion of the elongated members, wherein each blade member (13) is placed in contact with a projection (15) on the jaw portions, and projection welded (i.e. applying a current & force to urge the blade towards the projection) (column 1, lines 25+, & Figures 1-4).

Regarding claim 44, Coughtrie discloses the jaw portions (11) having a slot sized to receive the blade members (13). As illustrated in Figures 1-2, elongated member (11) has a recess or "slot" formed therein where the blade member (13) is welded into position via the projections (18).

Regarding claim 45, Coughtrie discloses the jaw portion (11) also comprising a gripping surface (14). In other words, the member (13) serves as both the "blade" member in that it is capable of cutting, as well as a gripping surface (14) which is capable of gripping.

Regarding claim 46, Coughtrie discloses the blade member (13) extends radially with respect to the pivot axis (which is indicated by the circular hole in member 11 as shown in Figure 1).

Regarding claim 51, Coughtrie discloses applying a second current to the weld (column 2, line 121).

Regarding claim 54, Coughtrie discloses the blade members in abutting relation upon closing (Figure 1).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47-50, 58-66, 72-79, 82, 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coughtrie in view of Graham (US Patent No 1373555).

Regarding claims 47-50, Coughtrie discloses the claimed invention except for assembly the blade while the elongated members are in a closed position.

Graham discloses assembling a blade to elongated members so as to be in abutting relation when the members are in a closed position; which is capable of being performed while the members are in a closed position. This is advantageous in that it decreases the assembly time, and facilitates the ease of replacing the blades once they become dull or worn. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a tool as disclosed by Coughtrie, while attaching the blades with the members in a closed position as taught by Graham in order to realize these advantages.

Regarding claims 58-60, 72-79, 82 Coughtrie does not disclose a blade having a ramped surface.

Graham discloses a blade (13) having a cutting edge, and the lower blade member (or anvil) has a ramped surface (14) such that light can not pass through. The use of such a configuration is beneficial in that the cutting edge enables a sharper, more precise cut than the

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blade of Coughtrie. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a tool as disclosed by Coughtrie, with a blade configuration as taught by Graham in order to afford these advantages.

Regarding claims 61-66, 85-87 Coughtrie discloses the claimed invention as discussed above, except for a transverse slot formed in the member (11).

Graham discloses a transverse slot (10) for receiving the cutting blades as discussed above. The use of the transverse slot is advantageous because it allows the blades to be mounted perpendicularly to the gripping plane, thereby increasing the utility of the tool. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a tool as disclosed by Coughtrie, with a transverse slot as taught by Graham in order to realize these advantages.

Claims 52-53, 67-69, 83-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coughtrie.

Coughtrie discloses the claimed invention except for explicitly stating the specific hardness factor; applying an additional current to the weld; and the configuration of the projections. It would have been an obvious matter of design choice to apply an additional current; forming the specific hardness; and employing the projection configuration claimed, since applicant has not disclosed that such requirements solve any stated problem or are for any particular purpose. Further, the Coughtrie invention appears to be able to perform equally well.

*Allowable Subject Matter*

Claims 55-57, 70-71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 3/17/05 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J Kenny whose telephone number is 571-272-4531. The examiner can normally be reached on mon - fri 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sk S. Kenny

  
DAVID P. BRYANT  
PRIMARY EXAMINER